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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINICHIRO MORITA,
TOSHIHARU SHIN'OKA, and YASUHARU IMAI

Appeal 2008-005884
Application 10/070,938
Technology Center 1600

Decided: September 10, 2009

Before JAMES T. MOORE, *Vice Chief Administrative Patent Judge*,
DEMETRA J. MILLS, ERIC GRIMES, LORA M. GREEN, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing of the panel decision entered June 4, 2009 (“Decision”), which affirmed rejections of claims 7-9, 11 and 15-19 (all of the pending claims) for obviousness. Although we have

expanded the panel to consider the request, the request for rehearing is nonetheless denied.

DISCUSSION

On rehearing, the Appellant must state with particularity the points believed to be misapprehended or overlooked by the Board (37 C.F.R. §41.52(a)(1)).

First, Appellants argue that that the Board did not specifically address the rejection under 35 U.S.C. § 112, second paragraph, asserting further that the claims are not indefinite (Req. Reh’g 4-5).

The panel did not address that rejection as it was withdrawn by the Examiner (*see, e.g.*, Ans. 4). Consequently, the panel could not have misapprehended or overlooked this issue.

Second, Appellants assert that the “Board erred by failing to give proper weight to the Applicant’s discovery of the source of a problem as part of an ‘as a whole’ inquiry.” (Req. Reh’g 1.) Appellants assert that the panel was incorrect in stating that the Appellants discovered an unknown problem (Dec. at 14). In fact, Appellants assert, they have discovered the source of a known problem (*id.* at 1-2). According to Appellants, “it was known that engineered cardiovascular grafts of tissue grown on fiber-based materials, are subject to catastrophic failure, even if tissue growth is apparently complete before implantation,” and that Appellants “discovered that the source of the problem was a lack of structural integrity in unreinforced fibers.” (*Id.* at 2.)

Appellants assert further that the issues in the instant case are analogous to the issues in *In re Sponnoble*, 405 F.2d 578 (CCPA 1969). In

that case, Appellants argue, the inventor found the source of a problem, and the court found that there was no teaching in the prior art that would suggest the necessity of the inventor's claimed solution (Req. Reh'g 2-3). Similarly, Appellants assert, “[n]othing in Vacanti or any of the other cited references described that the catastrophic failure that often occurs when implanting cardiovascular grafts results from insufficient structural integrity of the sponge.” (*Id.* at 3.)

These arguments are not persuasive.

First, contrary to the present argument, the Appellants specifically stated in their Appeal Brief that they “clearly discovered the existence of a problem not recognized by the cited prior art.” (App. Br. 5.) In discussing Vacanti, Appellants noted that “Vacanti suggests that heart valves engineered using the unreinforced matrix had sufficient strength for use in patients,” and that Appellants “were apparently the first to discover that this was wrong and that reinforcement of the starting material was required to avoid failure of the graft.” (*Id.*) Thus, in the Appeal Brief, the Appellants did argue that they discovered a problem that was apparently unknown in the art, and then discovered a solution to that problem.

Moreover, while Appellants now assert in the present Request for Rehearing that the claims present a solution to a known problem, Appellants have not pointed to any evidence of record that supports that assertion, and arguments of counsel cannot take the place of evidence in the record. *In re Scarbrough*, 500 F.2d 560, 566 (CCPA 1974).

In any event, the panel Decision found that “Vacanti provides evidence that the ordinary artisan was aware that matrices used in

cardiovascular repair had to have enough mechanical strength for the application for which they were being used" (Dec. 12-13). The panel also found that "Morita teaches that its reinforced matrix has increased strength when compared to a non-reinforced matrix" (Dec. 13). *See, e.g., Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings.")

Thus, the instant fact situation is distinguishable from the fact situation in *Sponnoble*, where there was evidence of record, such as affidavits and evidence of commercial success, of a known problem for which the claims at issue provided a solution and for which the prior art did not suggest a solution. *Sponnoble*, 405 F.2d at 587.

Second, as set forth by the United States Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007), "any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *See also In re Kemps*, 97 F.3d 1427, 1430 (Fed. Cir. 1996) (noting that for a prima facie case of obviousness to be established, the references need not recognize the problem solved by Appellants) (*see* Decision 4).

The panel concluded that the ordinary artisan would have been motivated to use a reinforced matrix such as that taught by Morita in the cardiovascular regeneration method of Vacanti in view of Morita's discussion of its increased strength (*id.* at 14), and the Appellants have not

pointed to any points that the panel misapprehended or overlooked in reaching that conclusion.

The Appellants in essence disagree with the result of the Decision. However, a request for rehearing must do more than re-argue issues that have already been decided, even if Appellants disagree with the previous decision or desire to restate their position differently. As noted above, a “request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a)(1). As the Appellants have not persuasively pointed out any points that the panel overlooked or misunderstood in rendering its decision, we deny the Request for Rehearing.

REHEARING DENIED

cdc

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